

REMARKS

Status of the claims: Claims 1-9, 12-19, 28-29 and 31 are currently pending. Claims 1, 2, 12, 18-19 and 28 are currently amended. Claims 10-11, 20-27 and 30 were previously canceled.

Claims 1, 2 have been rejected under 35 U.S.C. 103(a) over *Berger* (termed “Richard” by the Examiner) (US 4,499,912) in view of *Muramatsu* (US 5,394,895). Applicant traverses this rejection. *Berger* is drawn to a variety of filtered cigarette constructions; Figure 1 illustrates a filter wrapped in what *Berger* describes as an “air-impervious tipping paper...so that ambient air cannot enter the filter plug through the tipping paper” (col. 3 lines 25-30). Figure 2 illustrates a similar structure except that the grooves 28 are formed in the filter rod prior to applying the same air-impervious tipping paper. Because the respective tipping papers of Fig. 1 and Fig. 2 of *Berger* are impervious to air, air is drawn through the grooves to the smoker’s mouth.

Figures 3 and 4 of *Berger* illustrate a filter which is wrapped with a smoke-impervious plug wrap.

Accordingly with regard to the disclosure of *Berger* whether the material surrounding the filter plug is called a tipping paper or a plug wrap, it must be air or smoke impervious. There is no teaching, suggestion, or motivation to use any type of permeable material to wrap a filter plug.

The deficiencies of *Berger* as a reference are not cured by *Muramatsu*. *Muramatsu* discloses a more or less conventional prior art type filter construction which involves first

wrapping a filter plug with a plug wrap paper and then wrapping a tipping paper around the plug wrap. There is no teaching, suggestion, or motivation in *Muramatsu* that one could eliminate the two-layer wrapping of the filter plug, and replace it with only a single wrapping of permeable tipping paper, nor is there any teaching, suggestion, or motivation to do so when one combines the disclosures of *Berger* and *Muramatsu*. In fact both patent disclosures clearly teach away from the embodiments of Applicant's invention, whether viewed alone or in combination.

The embodiments of Applicant's invention utilize only a single wrapping of inherently permeable tipping paper having an inherent permeability of 50-500CU, around the filter plug. This is an elegantly simple, reliable, inexpensive, and easy way to manufacture a filter, which is not taught, suggested, or motivated by *Berger* or *Muramatsu* or any combination thereof.

Claim 3 has been rejected under 35 U.S.C. 103(a) over *Berger* in view of *Muramatsu* and *Barnes* (US 5,819,751). The reference to *Barnes* has been cited only in reference to its use of a foil wrapper. *Barnes* does not overcome the deficiencies of *Berger* and *Muramatsu* as references as discussed above, and claim 3 depends from claim 1 and is patentable for the same reasons.

Claims 4-6 have been rejected under 35 U.S.C. 103(a) over *Berger* in view of *Muramatsu* and *Molins* (US 4,040,430). Claims 4-6 are directly or indirectly dependent from claim 1. The deficiencies of *Berger* and *Muramatsu* as references as discussed above are not remedied by *Molins*, which has been cited only for its disclosure of an imprinted strip. Claims 4-6 are therefore patentable for the same reasons discussed above for claim 1.

Claims 7 and 8 have been rejected under 35 U.S.C. 103(a) over *Berger*, in view of

Muramatsu and *Perfetti* (US 4,998,541). *Perfetti* has been cited only for its disclosure of a strip materials percentage coverage of a filter length. *Perfetti* does not remedy the deficiencies of *Berger* and *Muramatsu* as references as discussed above, and since claims 7 and 8 depend directly or indirectly from claim 1, claims 7 and 8 are patentable for the same reasons discussed above for claim 1.

Claim 9 has been rejected under 35 U.S.C. 103(a) over *Berger* in view of *Muramatsu* and *Perfetti* and further in view of *Molins*. *Molins* is cited for its disclosure of a strip material configuration. Claim 9 depends directly from claim 1 and the deficiencies of *Berger* and *Muramatsu* discussed above with regard to claim 1 are not remedied by *Perfetti* and *Molins* as also discussed above. Therefore, claim 9 is patentable for the same reasons discussed for claim 1.

Claim 12 has been rejected under 35 U.S.C. 103(a) over *Berger* in view of *Muramatsu* and *Salonen* (US 5,595,196). *Salonen* has been cited only for its disclosure of a tipping paper basis weight. Since claim 9 depends directly from claim 1 and the deficiencies of *Berger* and *Muramatsu* as references have been discussed in reference to claim 1, *Salonen* does not remedy those deficiencies, and claim 12 is therefore patentable for the same reasons as discussed for claim 1.

Claims 13-17 have been rejected under 35 U.S.C. 103(a) over *Berger* in view of *Muramatsu* and further in view of *Bushby* (US 6,935,346). Claims 13-17 depend directly or indirectly from claim 1, and the deficiencies of *Berger* and *Muramatsu* as references have been

discussed above with regard to claim 1. *Bushby* has been cited for its disclosure of a ceramic filler, however, *Bushby* has no teaching, suggestion, or motivation which overcome the deficiencies of *Berger* or *Muramatsu* as references with regard to Applicant's embodiments as discussed with regard to claim 1, and accordingly claims 13-17 are patentable for the same reasons as discussed with regard to claim 1.

Claim 18 has been rejected under 35 U.S.C. 103(a) over *Molins* (US 4,040,430) in view of *Berger* and *Muramatsu*. The deficiencies of *Berger* and *Muramatsu* as references for Applicant's embodiments have been discussed above, particularly with reference to their failure to teach, suggest, or motivate the production of a filter-tip cigarette wherein the filter plug is wrapped only with a tipping paper having an inherent permeability of 50-500 CU. The *Molins* reference discloses only an apparatus for manufacturing a filter tip cigarette using double length conventional filters and ring tipping. There is no reference whatsoever to the use of a filter according to Applicant's embodiments which is wrapped only in an inherently permeable tipping paper of 50-500 CU. Accordingly the *Molins* reference does not cure the deficiencies of *Berger* and *Muramatsu* as references as discussed above. Therefore it is respectfully requested that this ground of rejection be withdrawn.

Claim 19 has been rejected under 35 U.S.C. 103(a) over *Molins* in view of *Brooks* (US 3,637,447) and further in view of *Berger*, *Muramatsu*, and *Clarke* (US 6,718,989). Despite the citation of five references, not one teaches, suggests, or motivates one to a method of producing the elegantly simple, reliable, inexpensive, and easily manufactured filter of Applicant's

embodiments as discussed above.

The deficiencies of *Molins*, *Berger*, and *Muramatsu* as references have been fully discussed above. The reference to *Clarke* is drawn to a highly complex filter structure comprising multiple layers of materials in various configurations. The reference to *Brooks* discloses another complex filter structure involving an intricately shaped plug of filtering material disposed within an axially elongated, hollow, outer member formed of plug wrap or plastic. In contrast Applicant's embodiments are formed basically from a plug of filter material wrapped only by an inherently permeable tipping paper of 50-500 CU. It is submitted that neither *Brooks* nor *Clarke* remedy the previously discussed deficiencies of *Molins*, *Berger*, and *Muramatsu* as references, and that claim 19 is therefore patentable over the combination of references.

Claims 28 and 29 have been rejected under 35 U.S.C. 103(a) over *Berger* in view of *Muramatsu* and *Clarke*. The deficiencies of each of those references have been discussed above. Additionally claims 28 and 29 are directly or indirectly dependent from claim 1 and are therefore patentable for the reasons discussed above in regard to claim 1.

Claim 31 has been rejected under 35 U.S.C. 103(a) over *Berger* in view of *Muramatsu* and *Salonen*. The deficiencies of *Berger*, *Muramatsu*, and *Salonen* as references have been fully discussed above. Additionally claim 31 depends directly from claim 1 and is therefore patentable for the same reasons previously discussed for claim 1.

Accordingly, it is submitted that this application is now in condition for allowance and

such action is respectfully requested. The Examiner is invited to contact the undersigned attorney by phone if there are any further issues that require discussion.

Respectfully submitted,

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